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NO. 6184 P. 3/7

Atty. Dkt. No. 042644-0303

REMARKS

A. Restriction Among Groups

Restriction is required in the Office Action (at page 2) between the following groups of claims:

Group I, including claims 1-28, drawn to methods for killing ectoparasites (including claims to compositions therefor); and

Group II, including claims 29 and 30, drawn to a method of making compositions for killing ectoparasites.

In response, Applicant hereby elects Group I, Claims 1-28, for examination, without traverse.

B. Restriction Among Species: Fatty Acid Esters

The Office Action also sets forth a requirement for election as between species of fatty acid esters embraced by the claims for examination. No evidence in support of the assertion that such species are patentably distinct has been provided. With traverse, Applicant provisionally elects isopropyl myristate as the species for examination.

MPEP Section 808.01 and .02 relate to restrictions among species and the proof that must be supplied to support such a restriction request. In that respect, Section 808.01 notes that:

Where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

Atty. Dkt. No. 042644-0303

Here, all of the fatty acid ester species share a common relationship in the context of the invention, in that each is identified as an agent for killing ectoparasites. As disclosed, the fatty acid ester species each have the same activity against ectoparasites, and are utilized in the compositions in the same concentrations. Therefore, the fatty acid ester species are related.

Section 808.02 notes that a restriction requirement among related species/inventions must be supported by evidence showing a serious burden would be imposed on the Examiner if a search of all the claimed species was made, to wit:

(A) Separate classification, where each species is shown to have attained recognition in the art as a separate subject for inventive effort, and also a separate field of search.

(B) A separate status in the art when the species are classifiable together. Even though they are classified together, each invention/species can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the inventions/species in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, etc., a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims.

Here, none of the evidence required by Section 808.02 for a *prima facie* case for restriction among species of fatty acid esters encompassed by the claims has been supplied. Indeed, Applicants respectfully submit that, because the use of fatty acid esters as a *killing* agent against ectoparasites is novel, a search of all species will not pose a significant burden on the Examiner. Reconsideration and withdrawal of the requirement for an election among the fatty acid ester species is therefore requested.

Atty. Dkt. No. 042644-0303

C. Restriction Among Species: Identity of Host

A requirement for an election among species of the invention wherein the lice killed are present on a human or on an animal has also been made, and is respectfully traversed. In this respect, Applicants' provisional election for examination is for the human species.

Traversal is made on the basis that the identity of the host is not critical to the invention. No evidence to the contrary has been provided.

In particular, the methods and compositions of the invention are directed to the ectoparasites to be killed, and not to the host. The identity of the host is not pertinent—the invention would work against ectoparasites no matter where they are located, even if on an inanimate object rather than a living species. The choice whether to apply the invention to a human or animal is of commercial, rather than technical, relevance. Therefore, the art to be searched will not make a distinction among hosts that would pose any additional burden in searching compositions and methods useful in killing ectoparasites on humans or animals.

Consistent therewith, no restriction among species of host was made in the parent application, which issued with claims generic to application of the invention to all hosts on which ectoparasites may be found. Reconsideration and withdrawal of the restriction requirement is therefore respectfully requested.

D. Restriction Among Species: Identity of Ectoparasite

The Office Action asserts that all species of ectoparasites whose eradication is embraced by the claims are patentably distinct within the context of the invention, and so requires election among them. No evidence is provided in support of the assertion. The requirement is respectfully traversed, subject to the provisional election of lice as the species for examination.

Atty. Dkt. No. 042644-0303

No evidence is of record that would lead one of skill in the art to conclude that the invention might work on one ectoparasite but not another, or that the prior art to be searched would make such a distinction among ectoparasites in classifying treatments therefor. To the contrary, the present application provides data evidencing efficacy of the invention against lice, lice eggs, and ticks. Consistent therewith, no restriction among species of ectoparasites was made in the parent application, which issued with claims generic to treatment of all ectoparasites.

Thus, Applicants respectfully submit that no undue burden will be imposed on the Examiner if a search for treatments of all ectoparasites encompassed by the claims is made. No *prima facie* case to the contrary has been made. Reconsideration and withdrawal of the requirement for an election among the ectoparasite species is therefore requested.

E. Restriction Among Species: Identity of Added Pesticide

The Office Action asserts that all species of pesticides that might be added to the invention are patentably distinct within the context of the invention, and so requires election among such species. No evidence is provided in support of the assertion. The requirement is respectfully traversed, subject to the provisional election of S-methoprene as the species for examination.

The independent claims of the invention all provide that the compositions contain an agent which is, by itself, sufficient to kill ectoparasites, said agent being a fatty acid ester. While one may add other agents, such as pesticides or decacyclomethicone, to provide additional activity or act synergistically with the fatty acid ester, patentability primarily turns on the role of the fatty acid ester, and not of such additional agents (see, e.g., Paragraphs 0014 and 0015 of the Specification). Therefore, the identity of added pesticides, if any, would be left to those of ordinary skill in the art to choose depending on the context in which the invention is to be utilized, and is not critical to the invention.

NOV. 6. 2006 3:47PM

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NO. 6184 P. 7/7

NOV 06 2006

Atty. Dkt. No. 042644-0303

Applicants therefore submit that no undue burden will be imposed on the Examiner if a search extending to pesticides that could be added to the invention were to be made. A *prima facie* case to the contrary has not been made. Reconsideration and withdrawal of the requirement for an election among the optional pesticidal species is therefore requested.

CONCLUSION

For all the foregoing reasons, Applicants respectfully traverse all of the species election requirements, subject to the provisional elections set forth above. Reconsideration and withdrawal of such species election requirements is requested.

As to the requirement for election between claims groups, Applicants have elected the claims of Group I, without traverse.

The claims are now believed to be in condition for allowance. Early and favorable consideration thereof is requested. If the Examiner believes that it would be helpful to discuss any of the issues raised by the Office Action or claims, he is invited to contact the undersigned.

Respectfully submitted,

Date 11-6-2006

By



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